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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,024	07/22/2005	Hiroshi Kawato	265768US0PCT	4769
22850	7590	11/15/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SANDERS, KRIELLION ANTIONETTE	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/526,024

Applicant(s)

KAWATO ET AL.

Examiner

Kriellion A. Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendment after final rejection has been entered. New prior art has been located which presents basis for a new ground of rejection. The finality of the previous office action is withdrawn.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 8-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nodera et al, US Patent No. 6,465,555 in view of Okamoto et al, US Patent No. 6,987,141.

2. Nodera et al discloses a composition comprising 85 parts of polycarbonate, 0.5 parts of methoxysilicone compound, 0.2 parts of PTFE and 4 parts of titanium oxide. See cols. 13 and 14, Table 1 of the patent. Patentee indicates that the polycarbonate resin for use in the invention may be a copolymer having a polycarbonate moiety and a polyorganosiloxane moiety. See col. 4, line 64 through col. 5, line 12. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to formulate a resin composition comprising 85 parts of polycarbonate-polyorganosiloxane copolymer, 0.5 parts of methoxysilicone compound, 0.2 parts of PTFE and 4 parts of titanium oxide. Such a formulation clearly overlaps applicant's claimed composition. Because a component and its concurrent functions may not be separated, all of the

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properties set forth in applicant's present claims would have inherently been achieved in the formulation of the compositions of Nodera et al.

3. Okamoto documents the polycarbonate-polyorganosiloxanes and compositions thereof that additionally comprise PTFE and titanium oxide, clearly indicating the compatibility of these components. The ordinary practitioner of this art would have found it obvious to look to the teachings of Okamoto et al in selecting a specific polycarbonate-polyorganosiloxane copolymer.

Okamoto et al discloses a polycarbonate resin composition (3) that includes components A, B, C and D. The composition comprises A) 100 parts by weight of an aromatic polycarbonate-polyorganosiloxane copolymer having a terminal group of formula (III-1) and B) an aromatic polycarbonate. The composition additionally comprises C) 0.05 to 1 part by weight of fibril-forming polytetrafluoroethylene, and D), an aromatic polycarbonate-polyorganosiloxane copolymer having a terminal group of formula (III-2). Component D) is an organosiloxane and thus meets the requirements of applicant's component (E). See col. 5, line 35 through col. 6, line 44 and col. 29, line 61 through col. 38, line 30. Patentee indicates that the composition may further include additional fillers and additives, specifically titanium oxide. See col. 37, lines 33-44.

The polycarbonate-polyorganosiloxane copolymer is defined by formula (III-4) and includes polydimethyl siloxane. See col. 31. The polyorganosiloxane content of the polycarbonate-polyorganosiloxane copolymer is from 0.5 to 10% by weight of the total polycarbonate resin. This overlaps the weight limitations of applicant's claim 2. See col. 32, lines 43-52.

Since patentee indicates that titanium oxide may be used in a generic sense and does not differentiate between any species of titanium oxide, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize any titanium oxide, including one having a surface acid or surface base content of 10 $\mu\text{mol/g}$ or more absent a clear showing of unexpected results attributable to the surface acid or base content.

The composition also includes a component D), which is an additional polycarbonate-polyorganosiloxane and meets the limitation of applicant's claim 6. See all of col. 34.

The compositions are injection molded to produce articles that are useful for example in an electrical apparatus. Therefore a molded sheet or film useful in an electrical apparatus would have been contemplated at the time of applicant's invention.


Polycarbonate compositions have long been recognized for their use in formulating plastic lenses, such as found in a light reflector. Formulation of such a component is obvious. Since a component and its function may not be separated, properties attributable to the titanium oxide additive, such as reflectance values, would be inherent in the compositions of Okamoto et al, since patentee clearly suggests the inclusion of this component.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 8:30am-7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kriellion A. Sanders
Primary Examiner
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